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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,600	02/11/2002	Jinglin Li	161765.00465 (SO-3163/01/	2753
22907	7590	12/18/2003	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			SACKEY, EBENEZER O	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/072,600	Applicant(s) LI ET AL.	
	Examiner EBENEZER SACKKEY	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1, 65 and 66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
     1. ☐ Certified copies of the priority documents have been received.  
     2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>05/07/03</u> | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1, and 65-66 are pending.

This is in response to applicants amendment filed on 09/04/03.

Receipt is acknowledged of the I.D.S. filed on 05/07/03. A signed copy of the 1449 is attached herewith.

Claims 1 and 65-66 rejected under 35 USC 102 (e) has been withdrawn.

### ***Response to Restriction***

Applicant's election with traverse of Group I filed on 09/15/03 is acknowledged. The traversal is on the ground(s) that the claimed compounds can be prepared by one or more than one process has no bearing on whether restriction within a Markush group is proper and additionally the substantial burden on the Examiner is negated by all seven groups being commonly classified in class 549. This is not found persuasive because even though all the restriction groups are commonly classified in class 549, they fall under several subclasses. Each group would also require a separate electronic search and manual data base search that are not co-extensive. These searches would also require separate search considerations and strategies. All of which could impose a serious burden on the office if all the groups were examined in one application. Each of the substituents on formula (I) are recognized in the art as being distinct from one another because of their chemical properties and modes of action, thus, a process for making compounds of for example Group III would not be obvious over a process for

making compounds of Group I. Applicants argue next that the unstated rationale for the restriction requirement appears to be the variety of groups pendant from the core of formula (I) and that alone cannot afford the basis for requiring restriction. In response, applicants have not argued that the various groups are indistinct. The Markush claim is generic to a plurality of distinct species encompassing compounds that have acquired a separate status in the art. Lastly, applicants argue that the restriction approach is procedurally in direct contrast to well-established examination principles set forth in MPEP 803.02. In response, the restriction provided herein is based on 35 USC 121 and not on MPEP 803.02. Harnish, Weber etc are all case laws drawn to improper Markush rejections under 35 USC 121 and **NOT** restrictions under 35 USC 121., Furthermore, these claims are not being rejected as containing improper Markush groups. The claims are being restricted under 35 USC 121. Thus, *In re Jones* and *Ex parte Dahlen* line of case law have no bearing on the issue of restriction.

Instantly, the restriction within Markush group of claim 1 is based on the distinctiveness of the vastly grouped species having disparate classifications and status in the art. Applicants have not provided any evidence to the contrary.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1 and 65-66 are objected to as containing non-elected subject matter. See elected Group I, claims 1 and 65-66 (in part) which are drawn to a method of preparing an enantiomerically-enriched tetrahydrobenzothiepine-1-oxide of formula (I) wherein R<sup>1</sup> and R<sup>2</sup> is H, alkyl, alkenyl and alkynyl; R<sup>3</sup> is H, alkyl, alkenyl, alkynyl, aryl and cycloalkyl where aryl can be substituted with alkyl, alkenyl, alkynyl, polyalkyl and

OR<sup>19</sup> wherein R<sup>19</sup> is H, alkyl, alkenyl, alkynyl, polyalkyl; R<sup>4</sup>, R<sup>5</sup>, R<sup>6</sup>, and R<sup>7</sup> are H, alkyl, alkenyl, alkynyl and halo.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (703) 305-6889. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

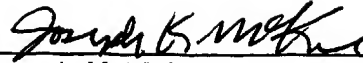
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EOS

December 15, 2003

A handwritten signature in black ink, appearing to read "Joseph K. McKane", is written over a horizontal line.

Joseph K. McKane

Supervisory Patent Examiner

Art Unit 1626, Group 1600

Technology Center 1